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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/249,660	02/12/1999	YUKIHISA NAKAJO	P 245595	1181

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EXAMINER
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PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 01/29/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/249,660

Applicant(s)

NAKAJO, YUKIHISA

Examiner

Aristotelis M Psitos

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Applicants' response of 10/28/03 has been considered with the following results.

***Claim Objections***

The examiner can discern no patentable distinction/claim differential between claims 14 and 15.

At present these claims are merely objected to, and the examiner eagerly awaits applicants' response.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 13,14,15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As newly amended, the claims recite the desired result that "pit forming efficiencies of the inner and outer circumference sides of the track relative to the offset light beam are balanced." The examiner fails to find clear adequate support in the specification as originally filed for such language.

The elected species refers to the ability of offsetting the tracking signal in accordance to find a particular point in which the absolute value of the te signal is obtained, and thereby shifting the laser beam so as to minimize such absolute value – radially outward to the track center (page 27 of the disclosure). Although the disclosure refers to decreasing the influence of residual heat from the adjoining inner track, there is no clear description (as originally filed) that the newly introduced claim language can describe such.

The examiner has read applicant's comments with respect to the prior art and this claimed language but maintains the new matter rejection accordingly.

The examiner considers the phrase "... are balanced" not to be supported. Alternatively, if applicant replaces such with the phrase ... is minimized ... the examiner would no longer maintain this rejection.

a. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 16 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 16 fails to include the control ability, hence as disclosed, and previously claimed and argued, this claim fails to particularly point out and distinctly claim the invention.

AS FAR AS THE CLAIMS RECITE POSITIVE LIMITATIONS and are interpreted by the examiner, the following art rejections are made.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 13,14,15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Takeda et al.

Applicants' attention is drawn to figure 4 and its disclosure, starting at col. 4 line 7. As depicted, there are offset values for optimum mode/signal performance. Such performance yields the newly introduced/claimed limitations.

With respect to claim 14, applicant's attention is drawn to figures 3 & 4 in Takeda et al and the appropriate accompanying disclosure. The control ability is performed by element 7 while element 20 is interpreted by the examiner to retain a storage circuit for storing optimum offset values.

#### **Response to Arguments**

Applicant's arguments with respect to the claim has been considered but is not deemed persuasive.

With respect to the phraseology focusing on the "are balanced" position, the examiner not only considers such subject matter as new matter, but in broadly interpreting such a phrase the resultant so described is present in Takeda et al.

With respect to the argument that Takeda et al only discusses outwardly offsetting, the claims presented do not so distinguish. Furthermore, see col. 12 lines 33-68 and lines 36-39 in col. 22.

4. Claims 13,14,15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoshima considered with Takeda et al.

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Aoshima discloses an optical recording and reproducing system wherein although tracking control is performed, there is no offset ability for such. Aoshima does however recognize the influence of the laser power upon the recording medium and its impact upon the formation of the recording pits.

The Takeda et al reference teaches the ability of the offset in order to compensate for the conditions and such is considered to enable a variety of offset values (alphas) in order to optimize the offset ability accordingly.

It would have been obvious to modify the base system of Aoshima with the above additional the offset teaching from the Takeda et al reference, motivation is to compensate for the signals and record signals accordingly.

Again, the examiner concludes that as the recording signal is offset from the center of the track, the influence of any residual heat in the inner track would be minimized.

#### ***Response to Arguments***

Applicant's arguments with respect to the claim has been considered but is not deemed persuasive.

With respect to the phraseology focusing on the "are balanced" position, the examiner not only considers such subject matter as new matter, but in broadly interpreting such a phrase the resultant so described is present in Takeda et al.

With respect to the argument that Takeda et al only discusses outwardly offsetting, the claims presented do not so distinguish. Furthermore, see col. 12 lines 33-68 and lines 36-39 in col. 22.

5. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by either EP 303936 or Miyagawa et al.

With respect to method claim 13, EP 303936 provides for tracking offset correction during recording see the description of the writing /recording operations commencing at col. 5 line 27 and culminating at col. 7 line 37.

With respect to Miyagawa et al – applicants' attention is drawn to col. 21 lines 24-53 wherein as described the examiner concludes the pit efficiency is balanced.

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**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.**

**Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2653



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